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D-1173 R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Thomas Mason)	
)	
Application No.: 10/697,956)	Art Unit 2887
)	
Confirmation No.: 7798)	
)	
Filed: October 30, 2003)	Patent Examiner
)	Tae Kim
Title: Delayed Annunciation Of Receipt)	
Jam For Cash Dispensing)	
Automated Banking Machine)	

Director of Technology Center 2800
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly enter the following petition without prejudice, which is being submitted within two months of the Advisory Action dated 9/10/2009. If further request for reconsideration by the Examiner is first required, then this petition should be considered as such.

PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

Initial Comments

Applicant petitions to have the final rejection dated 6/24/2009 withdrawn because it is premature and legally improper. Because of the premature final rejection, Applicant has not been given fair opportunity in accordance with 37 C.F.R. 1.111 to properly rebut the Office's newly imposed ground of rejection. Applicant also respectfully submits that the Office is committing prejudicial error by depriving Applicant of his administrative due process rights (e.g., timely notice of the Examiner's position and opportunity for unhindered response thereto). The record shows that the conditions did not meet the legal criteria for the Office to apply a final rejection on 6/24/2009. Thus, the final Office Action dated 6/24/2009 is premature.

Facts Of Record

In the Office Action dated 12/02/2008, claim 35 was rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Fukuda.

On 03/02/2009 the Applicant filed a Response to the Office Action of 12/02/2008. The Response did not include any amendment affecting claim 35.

In the Office Action dated 6/24/2009, claim 35 was *newly* rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Fukuda, and Motomura. The Office Action dated 6/24/2009 was made final.

On 8/12/2009 the Applicant filed a request to have the premature final rejection withdrawn.

The facts of record show that: (1) the examiner introduced a new ground of rejection; (2) the new ground of rejection was *not* necessitated by amendment of the claims; and (3) the new ground of rejection was *not* necessitated by an information disclosure statement (IDS).

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The Applicable Legal Standards

MPEP § 706.07(a) states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner *introduces a new ground of rejection* that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

MPEP § 706.07(f) (III) (M) states:

"If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action should be withdrawn . . . the Office action should begin with a statement to the effect: 'The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below.' Form paragraph 7.42 could be used in addition to this statement. See MPEP 706.07(d)."

In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

Ex parte Sabathie, BPAI decision dated 01/30/2001 in Appeal No. 2000-1332.

(Particularly note the BPAI decision at footnote 1 on page 8).

The Final Rejection Is Premature

Any reference being relied upon in a rejection is required to be positively listed in the statement of the rejection, which is followed by the body of the rejection. If not positively listed in the statement of the rejection, then the reference is not considered part of the rejection. *In re Hoch*, supra. *Ex parte Sabathie*, supra.

As the record shows, Motomura was not listed in the statement of rejection of claim 35 in the Office Action dated 12/02/2008. Thus, newly applying Motomura to non amended claim 35 in the final rejection dated 06/24/2009 constitutes a premature final rejection.

Reply To The Examiner's Comments

In the Advisory Action dated 9/10/2009 the Examiner admits that the prior "rejection for claim 35 left out the Motomura reference". The Examiner also acknowledges Examiner "error". Nevertheless, without citing any legal basis, the Examiner somehow reasons that a "New rejection was not made for claim 35 in the office action dated 06/24/2009".

Applicant encourages the Examiner to review *In re Hoch*, supra and *Ex parte Sabathie*, supra. As stated therein, "*there is no excuse* for not positively including the reference in the statement of the rejection".

Additional Comments

MPEP § 706.07(e) makes clear that when a final rejection is withdrawn, all amendments that were filed in response to that final rejection are entitled unhindered entry. Thus, removal of the final rejection dated 06/24/2009 results in automatic entry of any filed after-final amendment.

Conclusion

Applicant petitions that the final rejection of 06/24/2009 be withdrawn because it is *prima facie* premature. Applicant's petition should be granted for the reasons presented herein. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



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